Remarks and Arguments

Reconsideration is respectfully requested.

Claims 26-41 are pending in the present application before this amendment. By the present amendment, claims 26 and 35 have been amended. No new matter has been added.

Claim Rejections Under 35 U.S.C. 112

In the office action (page 2), claims 26-41 stand rejected under 35 U.S.C. §112, ¶2 as being indefinite since the feature "the read information" in claim 26 and "the obtained information" in claim 35 have not any antecedent basis, and claims 27-34 and 36-41 incorporate one of those errors therein.

The applicant has amended the feature "the read information" in claim 26 as --the indication information--, and "the obtained information" in claim 35 as --the necessary indication information--. The applicant believes that these amendments address each and everyone of the rejections of claims 26-41 under 35 U.S.C. 112, and withdrawal of the rejections of claims 35-41 under 35 U.S.C. 112 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

In the office action (page 3), claims 26-34 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,606,707 (Hirota) in view of U.S. Patent No. 6,282,611 (Hamamoto). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d

981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As the applicant mentioned in response to the office action mailed on May 19, 2009, *Hirota et al* discloses a PC 102 for downloading digital contents like music contents from network to the semiconductor memory card, and a portable play apparatus 201 for playing the downloaded digital contents after the semiconductor memory card is testified by the portable play apparatus. The PC 102 comprises a display 103, and the play apparatus 201 comprises a flash memory 109 and a display 203. In the currently pending office action, the examiner alleges that *Hirota et al* has disclosed the feature of claim 26 regarding the indication information in 21/39-43, 22/56-64, 10/6-10 and 13/58-14/25. The applicant respectfully disagrees.

In 21/39-43, *Hirota et al* **only** discloses that "*an external device such as the PC 102 or the player 201 issues the not-detected block list command to the memory card 109 during an idle time in which the memory card 109 is not accessed (S1201). On receiving the command, ...*", but there are **no** contents to describe or suggest that any of the PC 102, the player 201, and the memory card 109 has an indication information storage region for storing indication information regarding operating status thereof and the information of operating status is **present** to any information indication module. However, according to claim 26 of the presently claimed application, the operating status is stored in the indication information storage region and is presented to the indication module, **such that the user is aware of the currently operating status of the semiconductor storage apparatus when accessing the semiconductor storage**

medium module.

In contrast, 10/6-10, *Hirota et al* **only** discloses that the nonvolatile memory has capacity of 64K; and in 13/58-14/25 *Hirota et al* **only** discloses that the size of the authentication area is changed or resized as the examiner mentioned in the OA. Therefore, *Hirota et al* **never discloses or suggests that any of the PC 102, the player 201 and the memory card 109 has an indication information storage region for storing available storage capacity thereof or the available storage capacity information is present to a user thereof.** While, according to the amended claim 26 of the presently claimed invention, the semiconductor storage medium module has an indication information storage region in which the indication information of available storage capacity of the storage medium module is stored, and the available storage capacity information is **presented** to an information indication module such that the user is timely made aware of the available storage capacity when **accessing** the semiconductor storage medium module.

Moreover, the examiner also alleges that a controller module of *Hirota et al* is equivalent to the controller module of claim 26 of the presently claimed application. However, the applicant is not aware which part or device in *Hirota et al* the examiner refers to the controller module. The applicant believes that there is **not** such a module in *Hirota et al* that could read (i.e.; through for example some firmware) the indication information for indicating the semiconductor storage apparatus's operating status, user identification, and the available storage capacity of the semiconductor storage medium module so as to present the indication information to the information indication module, as claimed in claim 26 of the presently claimed application.

Hamamoto et al **only** discloses a memory card that includes a rechargeable battery as a power source. However, *Hamamoto et al* does **not** cure the deficiency of *Hirota et al*. Therefore, claim 26, as amended, is not obvious over *Hirota et al* in view of *Hamamoto et al* . Accordingly, claims 27-34 are patentable over *Hirota et al* in view of *Hamamoto et al* because they depend on claim 26 and recite patentable subject matter of claim 26. Withdrawal of the rejection of claims 26-34 under 35 U.S.C. § 103 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102

In the office action (page 7), claims 35-41 stand rejected under 35 U.S.C. §102(e) as being anticipated by Hirota.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic Research & Foundation v. Genentech Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As discussed in the above, *Hirota et al* does not teach or suggest any contents in regard to obtaining an available storage capacity of the storage medium module and **presenting the available storage capacity to user**. That is, *Hirota et al* does **not** disclose the steps of: --obtaining a necessary indication information from the indication information storage region, wherein the necessary indication information including at least one of information regarding operating status of the semiconductor storage

apparatus, identification of user associated with the semiconductor storage apparatus, and available storage capacity of the storage medium module-- and --presenting the necessary indication information in the information indication module--, as disclosed in claims 35, as amended. Therefore, claim 35 is not anticipated by *Hirota et al*.

Accordingly, claims 36-41 are not anticipated by *Hirota et al*, because they depend on claim 35 and recite all the limitations of claim 35. Withdrawal of the rejection of claims 35-41 under 35 U.S.C. § 102 is respectfully requested.

For the reasons set forth above, the applicants respectfully submits that claims 26-41, now pending in this application, are in condition for allowance over the cited references. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and earnestly solicits an indication of allowable subject matter. This amendment is considered to be responsive to all points raised in the office action. Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

When issuance of a Notice of Allowance is proper in the next action, the examiner is authorized to cancel the withdrawn claims, for which the applicant reserves the right to file a divisional application.

Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

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Keith S. Van Duyne

Keith S. Van Duyne, Reg. No. 54,505
Ladas & Parry
224 South Michigan Avenue
Chicago, Illinois 60604
(312) 427-1300